

09/546,962

T130

REMARKS

Claims 1-23 are currently pending in the subject application. Favorable reconsideration of the subject application is respectfully requested in view of the comments herein.

I. Rejection of Claims 1-23 Under 35 U.S.C. §102(e)

Claims 1-23 stand rejected under 35 U.S.C. §102(e) as being anticipated by Brobst *et al.* (U.S. Patent No. 6,053,409). It is submitted that this rejection be withdrawn for at least the following reasons. Brobst *et al.* does not disclose, teach, or suggest each and every limitation as set forth in the claims of the present invention.

For a reference to anticipate 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (*quoting Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Brobst *et al.* does not disclose *a beam expander* for reflecting a second portion of a light beam onto a target, as recited in independent claims 1, 15, and 23. Rather, Brobst *et al.* teaches an oscillating mirror actuated by a motor for producing a scanning beam (col. 5, lines 1-4). The oscillating mirror of Brobst *et al.* does not provide for an expansion of a light ray, as does the beam expander of claims 1, 15, and 23. In the Final Office Action dated August 21, 2002, it is stated that the beam expander reflects a light beam onto a target rather than expanding the light ray. However, as held in *Guttman, Inc. v. Kopykake Enters.*, 302 F.3d 1352 (Fed. Cir. 2002) (citations omitted) (emphasis added):

[i]t is black letter law that a patentee can choose to be his or her own lexicographer by clearly setting forth an explicit definition for a claim term that could differ in scope from that which would be afforded by its ordinary meaning. *The specification acts as a dictionary when it expressly defines terms used in the claims* or when it defines terms by implication. Where the patentee has clearly defined a claim term, that definition usually is dispositive; it is the single best guide to the meaning of a disputed term.

09/546,962

T130

A beam expander is defined in the specification of the subject application as preferably a polished round pillar located in a fixed location relative to the piezoelectric material, light source, and aperture window. *The arcuate reflective outer surface provides for an expansion of the light ray from the light source thereby further amplifying the scanning field size achievable with a piezoelectric material which itself may have a fixed maximum displacement.* The beam expander may alternatively have a spherical reflective outer surface in order to achieve two-dimensional expansion of the light ray. (See page 14, lines 13-20). Thus, although the beam expander may provide the additional function of reflecting a light beam onto a target, as recited in the claims, the beam expander also provides for an expansion of the light beam, as defined in the specification. The oscillating mirror of Brobst *et al.* does not provide for an expansion of a light beam. Accordingly, Brobst *et al.* does not disclose a beam expander (*e.g.*, each and every element) as set forth in independent claims 1, 15, and 23.

Regarding claim 21, the Examiner contends that Brobst *et al.* clearly teaches the polygonal scan mirror and the oscillating mirror to reflect the light beam from the light source onto the target. However, it is submitted that Brobst *et al.* does not disclose *whereby said light beam is expanded by the mirror* as recited in the subject claim. Expanding a light beam is absent from Brobst *et al.* Thus, Brobst *et al.* does not describe each and every element as set forth in claim 21.

For the aforementioned reasons, Brobst *et al.* neither anticipates nor makes obvious the subject invention as recited in claims 1, 15, 21, and 23. Claims 2-14, 16-20, and 22 respectively depend from claims 1, 15, and 21. Accordingly, withdrawal of this rejection and allowance of claims 1-23 are respectfully requested.

09/546,962

T130

II. Conclusion

The present application is believed to be in condition for allowance in view of the herein comments.

If any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number listed below.

Respectfully submitted,

AMIN & TUROCY, LLP



Himanshu S. Amin

Reg. No. 40,894

AMIN & TUROCY, LLP
24TH Floor, National City Center
1900 E. 9TH Street
Cleveland, Ohio 44114
Telephone: (216) 696-8730
Facsimile: (216) 696-8731

FAX COPY RECEIVED

OCT 21 2002

TECHNOLOGY CENTER 2800